

REMARKS

Claim 4 is pending and independent. Claims 2 and 3 are canceled.

Present Invention

The present invention is related to a photographic photosensitive material that is dedicated for digital processing. The photosensitive material does not include both a color correcting function and a sharpness enhancing function at the same time. In other words, the photosensitive material does not have simultaneously both a color correction function and a sharpness enhancing function.

Bohan et al. and Suzuki et al.

Claims 2-4 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Bohan et al. (U.S. Patent No. 5,837,433) in view of Suzuki et al. (U.S. Patent No. 6,094,218). Applicant respectfully traverses this rejection.

Applicant respectfully submits that the Examiner has not established a *prima facie* case of obviousness for at least the following reasons. First, the Examiner has failed to show that the prior art references teach all of the claimed features. Second, there is insufficient motivation for one of ordinary skill in the art to combine the teachings of Bohan et al. and Suzuki et al.

Applicant maintains and incorporates by reference the arguments submitted in the previous response dated June 18, 2002.

Bohan et al. disclose a method of providing a color image using color silver halide emulsion layers, which have chemical based color corrections by masking compounds, or Development Inhibitor Releasing (DIR) compounds. However, Bohan et al. also disclose that film may be digitally scanned and printed when digital processing occurs. The digital scanning and color correction process eliminates the need for the chemical based color corrections otherwise placed in the film. See Bohan et al. column 11, lines 19-23.

As admitted by the Examiner, Bohan et al. fail to disclose, "a material having a bar code in it or on the cartridge encasing it." See Office Action dated October 4, 2002 page 2, lines 14-15. To make up for this deficiency, the Examiner relies on Suzuki et al.

Suzuki et al. disclose a film with magnetic storage regions which may contain information limited to the type of film, frame number, total number of frames and the film type. However, Suzuki et al. teach nothing with respect to providing specific information about whether or not the, "photosensitive material either has said color correcting function or said sharpness enhancing function, and...said photographic photosensitive material does not contain a colored coupler for said color correcting function and a DIR coupler for said sharpness enhancing function at the same time," as recited, in part, by claim 4, as amended.

The Examiner uses Bohan et al. to make up for the deficiency of Suzuki et al. by stating,

the material of Bohan et al. teaches a silver halide photographic material having a color correction function due to a masking coupler and/or DIR coupler, interimage effects, and for an alternative method of processing such a material which includes a step of digital manipulation to produce a color corrected image. It is believed that since this type of material includes a unique processing step, a cartridge containing the film, which has a bar code, would include information about this unique step.

See Office Action dated October 4, 2002, page 5, lines 3-8 (emphasis added).

However, to establish a *prima facie* case of obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). See also MPEP 2143.

According to the standard stated in *In re Royka* and the MPEP, a § 103 rejection requires that the prior art teach all the claimed features. Therefore, it is not enough for the Examiner to merely base a rejection on the Examiner's "belief" that something must be true without an actual teaching that it occurs in the art. As a result, the Examiner is taking an overly broad position with respect to the contents of the teachings of Bohan et al. and simply creating teachings where none exist. This alleged teaching is clearly not inherent in the teachings of the reference. The teachings of Bohan et al. regarding the use of the silver halide emulsion layers for color correction are clearly limited to chemical processing of photographs and not digital photograph processing. Therefore, Bohan et al. and Suzuki et al., either alone or in combination, fail to teach or suggest "an identification code for digital processing is recorded...onto said photographic photosensitive material, or is recorded onto a storage

element...said identification code expressing that said photographic photosensitive material either has said color correcting function or said sharpness enhancing function, and...said photographic photosensitive material does not contain a colored coupler for said color correcting function and a DIR coupler for said sharpness enhancing function at the same time,” as recited by claim 4, in part, as amended.

Further, the teachings of Bohan et al. regarding the use of the silver halide layers having a color correction due to a coupler printer image effects is specifically related to silver halide photographic material and a digital photosensitive material. Therefore, Bohan et al. also do not teach or suggest, “A photographic photosensitive material dedicated for digital data processing which has a color correcting function for carrying out color correction of an image which has been subjected to developing processing or a sharpness enhancing function for enhancing sharpness of the image which has been subjected to developing processing,” as recited, in part, by claim 4, as amended.

Applicant further submits that based on the teachings of Bohan et al., one of ordinary skill in the art would not have been motivated to modify the magnetic storage area of Suzuki et al. by adding information regarding a color correcting function and sharpness enhancing function.

Bohan et al. explicitly states in at least two places that the use of digital scanning or reproduction equipment for image display eliminates the need for

color correction measures. First, column 10, lines 34-36, recite, "relying on the digital correction step to provide color correction obviates the need for color masking couplers in the elements." Second, column 11, lines 23-26 teach that digital image sharpening may be used on speed films intended for optical printing to supply higher quality pictures than color correction based on chemicals.

The comments provided by Bohan et al. regarding the ability of digital scanning technology to perform color correction indicate that digital scanning is a more sophisticated or at least a different technique than is capable of performing color correction and sharpness enhancing without the information of the silver halide emulsion layers. Otherwise, Bohan et al. would not disclose that digital image sharpening or color specific sharpening may be applied to speed film intended for optical printing eliminating the need for chemical based corrections. Further, it is known that digital image production is functionally different than chemical image production. Therefore, since digital scanning is a different technique with different capabilities it does not necessarily follow that one of ordinary skill in the art would be motivated to modify the magnetic storage of Suzuki et al. so that it has an, "identification code expressing that said photographic photosensitive material either has said color correcting function or said sharpness enhancing function, and...said photographic photosensitive material does not contain a colored coupler for said color

correcting function and a DIR coupler for said sharpness enhancing function at the same time,” as recited, in part, by claim 4.

Accordingly, the Examiner has not established a *prima facie* case of obviousness and claim 4 is allowable over the prior art.

Therefore, Applicant respectfully requests withdrawal of this rejection.

Bohan et al. and Nair et al.

Claims 2-4 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Bohan et al. in view of Nair et al. (U.S. Patent No. 5,753,426). Applicant respectfully traverses this rejection.

Bohan et al. and Nair et al., either alone or in combination, fails to teach all of the features of claim 4. As admitted by the Examiner, Bohan et al. fails to teach a material having a bar code in it or on the cartridge encasing it. See Office Action dated October 4, 2002, page 2, lines 14 and 15. To make up for this deficiency, the Examiner attempts to rely on Nair et al.

Nair et al. pertain to a photographic element which contains a transparent magnetic recording layer. The photographic element of Nair et al. is used for a color reversal sheet film, master for lithographic printing plates, and laser print film such as for a helium/neon gas laser or a red emitting LED laser printer. The magnetic particles are placed within the photographic element as a transparent layer that records information that is helpful to the photographer and a developing laboratory such as information regarding the frame of the

film, the light conditions, the speed at which the film is exposed, and the F-Stop number.

Although Nair et al. disclose a photographic material with a magnetic code embedded within it, Nair et al. do not disclose a photographic material for digital processing. Therefore, Nair et al. do not disclose, "a photographic photosensitive material dedicated for digital data processing,...wherein an identification code for digital processing is recorded optically or magnetically onto said photographic photosensitive material," as recited, in part, by claim 4.

Accordingly, claim 4 is allowable over the prior art.

Therefore, Applicant respectfully requests withdrawal of this rejection.

CONCLUSION

In view of the above amendments and remarks, reconsideration of the rejection and allowance of claim 4 is respectfully requested.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to contact the undersigned at (703) 205-8000, in the Washington, D.C. area.

Applicant respectfully petitions under the provisions of 37 CFR 1.136(a) and 1.17 for a two-month extension of time in which to respond to the Examiner's Office Action. The Extension of Time Fee in the amount of \$410.00 is attached hereto.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

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Attachment: Version With Markings Showing Changes Made



Application No. 09/374,989
Attorney Docket No. 1982-0129P

VERSION WITH MARKINGS SHOWING CHANGES MADE

IN THE CLAIMS

Claims 2-3 are canceled.

The claim has been amended as follows:

4. (Four Times Amended) A photographic photosensitive material dedicated for digital data processing which **[either]** has **[only one of or none of]** a color correcting function for carrying out color correction of an image which has been subjected to developing processing **[and] or** a sharpness enhancing function for enhancing sharpness of the image which has been subjected to developing processing, wherein an identification code for digital processing is recorded optically or magnetically onto said photographic photosensitive material, or is recorded onto a storage element provided at a cartridge accommodating said photographic photosensitive material, said identification code expressing that said photographic photosensitive material either has **[only one of or none of]** said color correcting function **[and] or** said sharpness enhancing function, **and**

when said photographic photosensitive material has said color correcting function, said color correcting function is due to at least one of a color correction and an image effect, or

when said photographic photosensitive material has said sharpness enhancing function, said sharpness enhancing function is due to a DIR coupler, and

said photographic photosensitive material does not contain a colored coupler for said color correcting function and a DIR coupler for said sharpness enhancing function at the same time.